

### REMARKS

Claims 1-20 are pending in the present application. Claims 1 and 13 are amended. Reconsideration of the claims is respectfully requested.

#### **I. 35 U.S.C. § 103, Obviousness**

The Office Action rejects claims 1-20 under 35 U.S.C. § 103 as being unpatentable over Heath et al. (US Patent No. 6,006,034), hereinafter referred to as "*Heath*," in view of *Rowley* (US Patent No. 5,999,740). This rejection is respectfully traversed.

With respect to claims 1 and 4, the Final Office Action states:

As per claims 1 and 4, Heath teaches a method of communication over the Internet in which data is transmitted over Internet connections from an Internet processor to Internet servers or between an Internet processor and an internet server over the Internet (see Fig.2B; col.3, lines 24-31; and col.4, lines 28-37), the improvement of displaying to the user of said Internet processor, before any data is transmitted over said Internet connection or to an Internet server, a message including an indication of the information (see col.4, lines 42-43: "list of the application components") to be transmitted (see col.4, lines 39-58). Heath does not explicitly teach about a cancel control for canceling the transmission, and allowing said user to cancel the transmission by selecting the cancel control. Rowley teaches about a cancel control for canceling the transmission, and allowing said user to cancel the transmission by selecting the cancel control (see col.5, lines 59-61). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ the teachings of Rowley within the system of Heath, by implementing a cancel button in an Internet-based software upgrade system, because this gives the user numerous reasons and control for canceling the transmission. Heath teaches of automatically canceling the transmission and re-routing to another server due to exceeded wait-time. By employing the addition of Rowley, the canceling can be done at any time by the control of the client.

Final Office Action, dated October 18, 2002. Applicant respectfully disagrees. Heath teaches a system and method for automatic application version upgrading and maintenance. The cited portion of *Heath* states:

In the Internet environment, for example, the call to a server for updating the application program can be made through a hypertext link on a Web browser directed to the

catalog on the server. The launcher program can be integrated into the browser as a helper application, a plug-in module, or as a browser control. When the link is selected from the client browser, the launcher is executed to update the corresponding application components on the client.

*Heath*, col. 3, lines 24-31.

In an open network architecture, such as the Internet and intranets, the centralized program updating is difficult due to the fact that the individual clients are not necessarily controlled by the server. In the Internet, for example, a Web server communicates with a remote client on an anonymous basis and cannot easily control the parameters of the client. FIG. 2A illustrates a preferred method of the present invention wherein a client 22 controls the process of a software upgrade in the client utilizing one or more servers 25 on a network. More particularly, in FIG. 2B, a software version upgrade can be initiated through executing an application program on the client 22. The execution command transmits a request signal 23 to the server 24 which holds the latest application components. In the preferred embodiment, the server responds by downloading a catalog of a list of the application components, each identified with the latest version number.

*Heath*, col. 4, lines 28-43. In *Heath*, the client sends a request 23 for an update to the server and a launcher retrieves the necessary components. However, *Heath* does not teach or suggest "a message including an indication of the information to be transmitted from the Internet processor," as recited in claim 1. The cited portion of *Heath* teaches a "list of the application components"; however, this list identifies information to be transmitted to the Internet processor, rather than from the Internet processor, as in claim 1. Furthermore, *Heath* fails to teach or suggest "a message including an indication of the Internet address of the Internet server to which the information is to be transmitted," as recited in claim 4. This limitation is not addressed in the rejection of claim 4.

*Rowley* teaches an updating mechanism for software. The cited portion of *Rowley* states:

Alternatively, the user may simply exit from the program without performing any updates by selecting the "Cancel" button.

*Rowley*, col. 5, lines 59-61. Thus, *Rowley* teaches a cancel control for canceling a transmission from a server to a client. *Rowley* does not teach or suggest “a message including an indication of the information to be transmitted from the Internet processor,” as recited in claim 1. The cited portion of *Rowley* teaches canceling an update; however, this update includes information to be transmitted to the Internet processor, rather than from the Internet processor, as in claim 1. Furthermore, *Heath* fails to teach or suggest “a message including an indication of the Internet address of the Internet server to which the information is to be transmitted,” as recited in claim 4.

In contradistinction, claim 1 recites:

1. In a method of communication over the Internet in which data is transmitted over Internet connections from an Internet processor to Internet servers, the improvement of displaying to the user of said Internet processor, before any data is **transmitted from the Internet processor** over said Internet connection, a message including **an indication of the information to be transmitted from the Internet processor** and a cancel control for canceling the transmission, and allowing said user to cancel the transmission by selecting the cancel control. [emphasis added]

Neither *Heath* nor *Rowley* concerns data transmitted from the Internet processor. Rather *Heath* and *Rowley* teach mechanisms for performing updates from a server to a client. Therefore, *Heath* and *Rowley*, taken alone or in combination, fail to teach or suggest “displaying... a message including an indication of the information to be transmitted from the Internet processor and a cancel control for canceling the transmission,” as recited in claim 1. Therefore, claim 1 cannot be rendered obvious by a combination of *Heath* and *Rowley*.

Claim 4 recites:

4. In a method of communicating between an Internet processor and Internet servers over the Internet wherein information is transmitted from said Internet processor to said Internet servers, the improvement of displaying to the user of said Internet processor, before transmitting information over an Internet connection to an Internet server, a message including an indication of the Internet address of the Internet server to which the information is to be transmitted and a cancel control for canceling the transmission, and allowing the user of said Internet processor to cancel the transmission by selecting the cancel control.

Neither *Heath* nor *Rowley* concerns data transmitted **from** the Internet processor. Rather *Heath* and *Rowley* teach mechanisms for performing updates from a server to a client. Therefore, *Heath* and *Rowley*, taken alone or in combination, fail to teach or suggest “displaying... a message including an indication of the Internet address of the Internet server to which the information is to be transmitted and a cancel control for canceling the transmission,” as recited in claim 4. Therefore, claim 4 cannot be rendered obvious by a combination of *Heath* and *Rowley*.

The present invention is directed towards methods of communication over the Internet in which data is transmitted over Internet connections from an Internet processor to an Internet server. Even if *Heath* and *Rowley* could be properly combined, the combination would not form the present invention recited in claims 1 and 4. Instead, a combination of *Heath* and *Rowley* would result in a method for performing a software update in which a list of software components in an update are displayed and the user can cancel the update.

Since claims 2, 3, 5, and 6 depend from claims 1 and 4, the same distinctions between *Heath* and *Rowley* and the invention recited in claims 1 and 4 apply for these claims. Additionally, claims 2, 3, 5, and 6 recite other additional combinations of features not suggested by the reference. Consequently, it is respectfully urged that the rejection of claims 1-6 is overcome.

More particularly, with respect to claim 2, the Office Action states:

As per claim 2, *Heath* further teaches wherein the message further includes the address of the Internet server to which the information is to be transmitted (see Fig.3B, #320 & #324; and col.4, line 65 to col.5, line 5).

Final Office Action, dated October 18, 2002. Applicant respectfully disagrees. The cited portion of *Heath* states:

In the preferred embodiment, as described in **FIG. 3B**, a catalog file is prepared to include application information **320** which includes the client download directory location(s) and the execution command to the application program. For each component that is now required, the catalog file includes at **324** a version identification, code or data size, and the network address(es) where the latest version of the component is stored.

Heath, col. 4, line 65, to col. 5, line 5. While *Heath* teaches a catalog file that includes a network address of a component file, the component file is information to be transmitted from the server and the catalog file is not a message to be displayed. Neither the cited portion nor any other portion of *Heath* teaches or suggests a message that includes the address of the Internet server to which the information is to be transmitted, as recited in claim 2.

*Rowley* actually teaches a display that allows a user to select target server to which information may be uploaded. However, *Rowley* fails to teach or suggest displaying a message including "an indication of the information to be transmitted from the Internet processor," "the address of the Internet server to which the information is to be transmitted," and "a cancel control for canceling the transmission," as recited in claim 2. Since the prior art, taken alone or in combination, fails to teach or suggest the claim limitations, claim 2 cannot be rendered obvious by the combination of *Heath* and *Rowley*.

Further, with respect to claim 3, the Office Action states:

As per claim 3, Heath further teaches wherein said message further includes a selection control for selecting the information to be transmitted (see col.1 lines 50-52; col.2, line 63 to col.3, line 3; and col.6 lines 3-19 & 21-25).

Final Office Action, dated October 18, 2002. Applicant respectfully disagrees. *Heath* and *Rowley*, taken alone or in combination, fail to teach or suggest "displaying... a message including an indication of the information to be transmitted from the Internet processor and a cancel control for canceling the transmission," as recited in claim 1. Therefore, it follows that *Heath* and *Rowley*, taken alone or in combination, also fail to teach or suggest the further limitation of a selection control for selecting the information to be transmitted. Therefore, claim 3 cannot be rendered obvious by a combination of *Heath* and *Rowley*.

Claims 5 and 6 recite subject matter addressed above with respect to claims 1-3 and are allowable for the same reasons. Claims 7-16 recite subject matter addressed above with respect to claims 1-6 and are allowable for the same reasons. Since claims 17-20 from claims 7-9, the same distinctions between *Heath* and *Rowley* and the

invention recited in claims 7-9 apply for these claims. Consequently, it is respectfully urged that the rejection of claims 1-20 is overcome.

With respect to claim 17, the Final Office Action states:

As per claim 17, Heath does not explicitly teach wherein the first selection is selected by default. However, Heath does teach that the system may be implemented to automatically update by an operating system or a launcher program at start-up (see col.2, lines 52-55), therefore, it is inherent in such a system to set priority and implement a default selection either by the server or client.

Final Office Action, dated October 18, 2002. Applicant respectfully disagrees. An operating system or launcher program automatically updating a client is not equivalent to the display of a message, the message setting forth the Internet address of the server to which information is to be transmitted, including a cancel control for canceling the transmission, including an indication of at least a first information item to be transmitted, including a first selection control for selecting the first information item to be transmitted, wherein the first selection control is selected by default, as specifically recited, in combination, in claim 17.

The Office Action does not address this feature other than to say that setting a priority and implementing a default selection is inherent. However, *Heath* does not display such a message including an indication of at least a first information item. *Heath* also does not teach or suggest a message that includes a selection control for selecting the first information item. Therefore, it follows that *Heath* does not teach or suggest selecting the selection control by default.

The Office Action misapplies the concept of "inherent" anticipation. An invention is said to be "anticipated" when it is squarely described or disclosed in a single reference as identified from one of the categories of 35 U.S.C. § 102, commonly referred to as "prior art". Express anticipation occurs when the invention is expressly disclosed in the prior art, patent or publication. In some cases, however, when the claimed invention is not described *in haec verba*, the "doctrine of inherency" is relied on to establish anticipation. Under the principles of inherency, a claim is anticipated if a structure in the prior art necessarily functions in accordance with the limitations of a process or method claim. *In re King*, 801 F.2d 1324, 231 U.S.P.Q. 136 (Fed. Cir. 1986). A prior art

reference that discloses all of a patent's claim limitations anticipates that claim even though the reference does not expressly disclose the "inventive concept" or desirable property the patentee discovered. *Verdgaal Brothers, Inc. v. Union Oil Company of California*, 814 F.2d 628, 2 U.S.P.Q.2d 1051, (Fed. Cir. 1987). It suffices that the prior art process inherently possessed at that property. *Id.*

Mere possibilities or even probabilities, however, are not enough to establish inherency. The missing claimed characteristics must be a "natural result" flowing from what is disclosed. *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 20 U.S.P.Q.2d 1746 (Fed. Cir. 1991). Unstated elements in a reference are inherent when they exist as a "matter of scientific fact". *Constant v. Advanced MicroDevices, Inc.*, 848 F.2d 1560, 7 U.S.P.Q.2d 1057 (Fed. Cir.), *cert. denied*, 488 U.S. 892 (1988) and *Hughes Aircraft Co. v. United States*, 8 U.S.P.Q.2d 1580 (Ct. Cl. 1988). Otherwise, the invention is not inherently anticipated.

In the present case, *Heath* does not even address data transmitted **from** an Internet processor. *Heath* also does not teach a message including a first selection control for selecting the first information item to be transmitted from an Internet processor. The assertion that these elements are present in *Heath* can be made only through the use of Applicant's disclosure as a template to fill in the missing elements. Therefore, the Office Action fails to establish a *prima facie* case of obviousness for claim 7. As such, the rejection is improper and should be withdrawn.

With respect to claim 18, the Final Office Action states:

As per claim 18, *Heath* does not teach of further comprising removing the first information item from the transmission before the information is transmitted responsive to deselection of the first selection control. Rowley teaches of removing the first information item from the transmission before the information is transmitted responsive to deselection of the first selection control (see Fig.9). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ the teaching of Rowley within the system of *Heath*, by removing selected item upon deselection from the selection control within the Internet-based software upgrade system, because such limitation is well known in user defining options in all software application.

Final Office Action, dated October 18, 2002. Applicant respectfully disagrees. The display shown in **FIG. 9** of *Rowley* lists updates to be downloaded from a server to a client. Thus, *Rowley* does not teach or suggest displaying a message including a first selection control for selecting the first information item to be transmitted to a server, as recited in claim 18. Since neither *Heath* nor *Rowley* individually teach this feature, the combination of *Heath* and *Rowley*, taken in combination, also fails to teach or suggest the limitation of claim 18. Therefore, claim 18 cannot be rendered obvious by *Heath* and *Rowley*.

Therefore, the rejection of claims 1-20 under 35 U.S.C. § 103 is overcome.

## II. Conclusion

It is respectfully urged that the subject application is patentable over *Heath* and *Rowley* and is now in condition for allowance.

The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE: 11/25/02

Respectfully submitted,



Duke W. Yee  
Reg. No. 34,285  
Carstens, Yee & Cahoon, LLP  
P.O. Box 802334  
Dallas, TX 75380  
(972) 367-2001  
Attorney for Applicants



## APPENDIX OF REDACTED CLAIMS

Please amend claims 1 and 13 as follows:

1. (Twice Amended) In a method of communication over the Internet in which data is transmitted over Internet connections from an Internet processor to Internet servers, the improvement of displaying to the user of said Internet processor, before any data is transmitted from the Internet processor over said Internet connection, a message including an indication of the information to be transmitted from the Internet processor and a cancel control for canceling the transmission, and allowing said user to cancel the transmission by selecting the cancel control.

13. (Twice Amended) A computer program product in a computer-readable medium for providing control over information transmitted from an Internet processor over the Internet:

means to establish Internet connections over the Internet between said Internet processor and Internet servers wherein said Internet processor can transmit information over said Internet connection;

means operative when information is about to be transmitted from the Internet processor over an Internet connection to display a message before the information is transmitted, said message including an indication of at least a first information item about to be transmitted from the Internet processor and a cancel control for canceling the transmission; and

means to cancel the transmission responsive to selection of the cancel control.